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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,974	05/23/2001	Robert J. Gartside	1094-10	1412

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EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863974

Applicant(s)

Gontsih

Examiner

Herbickson

Art Unit

1151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/9/03
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 22, 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sun 4778943.

Sun teaches in column 4 MgO catalyst, used to isomerize butene. Where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

Claims 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lowery et al 5153165.

Lowery teaches in column 5 MgO for double-bond isomerization, activated under nitrogen. No differences are seen versus the claimed catalysts. See *In re Brown* and *In re Fessmann*, *supra*.

Claims 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lowery et al. 5134103.

Lowery teaches in column 8 treating MgO catalyst in dry nitrogen. See *In re Brown* and *In re Fessmann*, *supra*.

Claims 1-7, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery '103 taken with Schaub 5077029.

Lowery does not teach how the nitrogen was made or its oxygen content, however Schaub teaches an essentially pure nitrogen in column 2. Using this in the process of Lowery is an obvious expedient to provide the dry, pure nitrogen used by Lowery. See *In re Kamlet* 88 USPQ 106. Although the conditions of claim 5 are more severe than those of Lowery, using the

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claimed longer time and higher temperature is an obvious expedient to assure completion and effectiveness of the treatment.

Claims 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery '103 taken with Schaub as applied to claims 1-7, 22 and 23 above, and further in view of Low et al. 5003118 and Didillon.

The above references do not teach treating to remove coke, however Low teaches in column 4 that coking is a problem in isomerization systems similar to those of Lowery. Didillon teaches the claimed steps of removing coke; the discussion in paper of 1/2/03 is incorporated herein. Using these steps is an obvious expedient to keep the catalyst effective for a long time.

Applicant's arguments filed 10/9/03 have been fully considered but they are not persuasive. Arguments to Sun are to features not claimed- reaction superiority, tolerance of alkali, etc. It is noted that claim 8 is evidence that the step of claim 1 is a 'regeneration' because claim 8 requires that the material was previously used. Note that Sun also treats butene, so no difference in reaction system is seen- especially ex. 4. The specification does not show a difference versus Sun, so arguments of superior results are not persuasive. Other arguments are moot in view of the new rejections. Didillon is combinable- even though a different catalyst is treated- because it removes coke from a fouled catalyst. An allegedly different reason for doing a known step is not persuasive; In re Dillon 16 USPQ 2d 1897.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.



Stuart Hendrickson
examiner Art Unit 1754